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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,389	04/30/2001	Gordon R. Nuttall	10003837-1	2738

7590 10/06/2005

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EXAMINER

WORKU, NEGUSSIE

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/845,389

Applicant(s)

NUTTALL ET AL.

Examiner

Negussie Worku

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on JUL 6, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/19/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted and was filed on Feb 18, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

2. Applicant's arguments with respect to claim 1, 13 and 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-21, are rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi et al. (USP 6,396,598).

With respect to claim 1, Kashiwagi et al. discloses an image data capture device (electronic memo processing 50 of fig 1, includes image data capture device scanner 62 of fig 1) for editing captured image data, the device (memo processing unit 50 of fig 1)

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Art Unit: 2626

comprising: at least one image data capture element (scanner 62 of fig 1); an image data processor for generating image files from image data acquired by said capture element (image captured by scanner (CCD) 62, is processed by memo processing device 50, includes computer (CPU) 80 of fig 5, see col.11, lines 5-15); and a user data entry device (a pen 60 of fig 4, an electronic memo 72 is written by means of a pen 60 on tablet 66 of fig 1, col.10, lines 63-68), for enabling a user to modify said generated image files, (memo 72 of fig 4, a modified image file) wherein said at least said one image data capture element, (scanner 62 of fig 6) said image data processor, (image memo processing device 50, includes computer (CPU) 80 of fig 5, for processing image see col.11, lines 5-15) and said user data entry device (a pen 60 of fig 4, an electronic memo 72 is written by means of a pen 60 on tablet 66 of fig 1, col.10, lines 63-68) are disposed within a portable container (300 of fig 18, see col.19, lines 17-25).

With respect to claim 2, Kashiwagi et al. discloses an image data capture device (scanner 62 of fig 1) wherein said image data capture element (CCD of scanner 62) is included in a digital camera, see (camera, col.11, lines 52-55).

With respect to claim 3, Kashiwagi et al. discloses the device (fig 1-3), wherein said image data capture element (50 of fig 1) is included in a scanner (data capture element 50 of fig 1, includes scanner 62 of fig 1 and 2, see col.11, lines 52-55).

With respect to claim 4, Kashiwagi et al. discloses the device (fig 1-3), wherein said user data entry device (input devices 276 of fig 17, which includes keyboard or

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Art Unit: 2626

pen) comprises a pressure-sensitive tablet (a tablet 282 of fig 17, see col.18, lines 50-57).

With respect to claim 5, Kashiwagi et al. discloses the device (fig 1-3), wherein said user data entry device (input devices 276 of fig 17, includes keyboard or pen) comprises an electro-magnetically coupled pen (pen 60 of fig 1) and writing surface (memo 72 is written by means of pen 60 on tablet 66 [a writing surface] as shown in fig 1 and 4, see col.10, lines 65-68).

With respect to claim 6, Kashiwagi et al. discloses the device (fig 1-3), wherein said user data entry device (input/output device 276 of fig 17, such as keyboard and pen as shown in fig 2) comprises means for entering text annotation data into said generated image files (a document file image 308 of fig 19, created by an application program, see col.19, lines 35-38).

With respect to claim 7, Kashiwagi et al. discloses the device (fig 1-3), wherein said user data entry device (input/output device 276 of fig 17, such as keyboard and pen as shown in fig 2) comprises means (pen 62 of fig 1) for entering graphical annotation data into said generated image files (pen 62 used by user for manually inputting a graphic figure to the display unit to generate image file, see col.10, lines 49-51).



With respect to claim 8, Kashiwagi et al. discloses the device (fig 1-3), further comprising means for entering image file processing instructions to said device (electronic memo processing apparatus 50 of fig 1, substantially consists of a computer, and includes CPU 80, where keyboard can be used as means entering image processing gives instruction to device shown in fig 1, see col.11, lines 5-10)

With respect to claim 9, Kashiwagi et al. discloses the device (electronic memo processing 50 of fig 1), comprising means for converting handwritten user entries employing said user data entry device into machine recognizable data (electronic memo processing apparatus 50 of fig 1, consists of a computer and includes CPU 80, where keyboard can be used as means entering image processing gives instruction to device shown in fig 1, see col.19, lines 35-40)

With respect to claim 10, Kashiwagi et al. discloses the device (electronic memo processing 50 of fig 1), wherein said user data entry device enables superimposition of user data entry on a display of an image file of said generated image files, (electronic memo processing apparatus 50 of fig 1, consists of a computer and includes CPU 80, where keyboard can be used as a user data entry device that gives instruction to device shown in fig 1, see col.19, lines 35-40)

With respect to claim 11, Kashiwagi et al. discloses the device (electronic memo processing 50 of fig 1), wherein said user data entry device enables annotation of said


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Art Unit: 2626

generated image files by direction, (electronic memo processing apparatus 50 of fig 1, consists of a computer and includes CPU 80, where keyboard can be used as means entering image processing gives instruction to device shown in fig 1, see col.19, lines 35-40)

With respect to claim 12, Kashiwagi et al. discloses the device (electronic memo processing 50 of fig 1), further comprising: a communication interface (366 of fig 20, col.20, lines 50) for coupling said device to a network, see (col.12, lines 10-15)

With respect to claim 13, Kashiwagi et al. discloses a method for annotating information in an image capture device, (electronics memo processing device 50 of fig 1, which includes scanner 62 of fig 6 for capturing image) the method comprising the steps of: capturing image data within said image capture device, see (col.11, lines 52-55); receiving user-entered data in connection with selected captured ones of said image data (document identifying unit 116 of fig 6, for specifying document information); annotating said selected ones of said captured image data with said received user-entered data, see (col.11, lines 25-30); and performing said steps of capturing, receiving, and annotating within a portable assembly, (document is set, see step 40 of fig 11, document identified, see step 144 of fig 11, read document, see step 148 of fig 11, see col.13, lines 25-45)



With respect to claim 14, Kashiwagi et al. discloses the method (shown in fig 1-5) comprising the further step of: providing a network interface within said portable assembly (a communication interface 366 of fig 20, col.20, lines 50, for coupling portable device (50 of fig 1) to a network, see (col.12, lines 10-15).

With respect to claim 15, Kashiwagi et al. discloses the method (shown in fig 1-5), wherein said annotating step comprises the steps of: displaying a first image file of selected captured image data (display unit 68 of fig 6, for displaying a captured image data read by document memo reading unit 106 of fig 6, see steps 100-110 of fig 6); superimposing said user-entered data on said displayed first image file (104 of fig 6, for addition/management (updating); and providing a continuously updated display of said first image file as modified by said user-entered data, see (col.11, lines 40-45).

With respect to claim 16, Kashiwagi et al. discloses the method (shown in fig 1-5), further comprising the step of: electronically mailing said annotated selected ones of said at least one image files to at least one recipient, said recipient specified in said annotating step, (a communication interface 366 of fig 20, col.20, lines 50, for coupling portable device 50 of fig 1, to a network, see col.12, lines 10-15).

With respect to claim 17, Kashiwagi et al. discloses the method (shown in fig 1-5), further comprising the step of: saving said annotated selected ones of said image data; see (col.12, lines 42-45).



With respect to claim 18, Kashiwagi et al. discloses the method (shown in fig 1-5), wherein said step of saving comprises the step of: transmitting said annotated selected ones of said image data over a public network to a node on said public network, (a communication interface 366 of fig 20, col.20, lines 50, for coupling portable device 50 of fig 1, to a network, see col.12, lines 10-15).

With respect to claim 19, Kashiwagi et al. discloses the optical scanner (scanner 62 of fig 1), comprising: means for capturing image data (scanner 62 of fig 6); means for displaying selected image data (display unit 68 of fig 6); means for receiving user-entered data in connection with said selected image data (an electronic memo display unit 6, receives entered data or display selected data by one of data entry device 276 of fig 17, step 210-220); means for superimposing said received user-entered data on said displayed selected image data (one of the data entry device 276 of fig 17, selected image data graphic or text displayed on the memo display unit 68 for further processing); and means for annotating said displayed selected image data with said superimposed received user-entered data, (one of the data entry device 276 of fig 17, step 210-240 of fig 14)

With respect to claim 20, Kashiwagi et al. discloses the optical scanner (scanner 62 of fig 1), further comprising: a communication interface (data distributed over computer net work, col.12, lines 5-15) for enabling said optical scanner (62 of fig 6) to

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Art Unit: 2626

communicate over a data communication network, (remote terminal or a server over a network) or under at least partial control of said means for annotating, see (col.12, lines 10-15).

With respect to claim 21, Kashiwagi et al. discloses the optical scanner (scanner 62 of fig 6) wherein the means for receiving comprises means for receiving handwritten graphical data (electronics memo processing 50 of fig 1, memo display unit 102 of fig 6) received hand written graphic data, see (col.12, lines 25-30).

### **Response to the arguments**

3. Applicant's arguments with regard to claims 1, 13 and 19 have been reviewed and respect fully considered. The previous office action has been withdrawn.

However, a new ground of rejection has been submitted in view of the prior art used in the last office action for the reason that in the last office action the teaching of the prior art have not been discussed or explained and a different element was used for the same limitation.

Therefore, Examiner still believe the prior art anticipates the claimed invention as discussed in the above office action of page 2 through 9, and this is a non-final office action.


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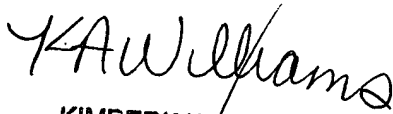
Art Unit: 2626

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Negussie Worku whose telephone number is 571-272-7472. The examiner can normally be reached on 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Negussie Worku  
09/30/05

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER